

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

28728-65

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/089,467

Filed

March 27, 2002

First Named Inventor

Howard D. Dean

Art Unit

3737

Examiner

Amanda L. Lauritzen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/ Luis A. Carrion /

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Signature

Luis A. Carrion

Typed or printed name

☒ attorney or agent of record.  
Registration number 61,255

216-363-4635

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

August 25, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of : HOWARD D. DEAN                      Examiner : AMANDA L. LAURITZEN  
Application No. : 10/089,467                                      Group Art : 3737  
Filing Date : MARCH 27, 2002                                  Docket No. : 28728-65  
Confirmation No. : 9628  
Title : METHOD AND APPARATUS FOR PRODUCING AN IMPLANT

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Commissioner:

Applicant requests review of the final rejection mailed on February 26, 2010 (the “final office action”) in the above-identified application (the “present application”) before submission of an appeal brief. No amendments are being filed with this request.

This request is being filed together with a notice of appeal.

The final office action set forth a three-month period for filing of a response. In accordance with 37 C.F.R. §1.136(a), applicant requests a three-month extension of time for filing. All fees associated with the three-month extension of time are being paid concurrently with the filing of this request. Accordingly, this response is timely filed.

Review is requested for the reasons stated below.

## CLAIM SUMMARY

Claims 1-7 and 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradbury et al. (US 2002/0059049).

Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradbury et al., as applied to claims 7 and 18 above, further in view of Ateshian et al. (US 6,126,690).

## REMARKS

Applicant requests reconsideration of the final office action rejecting all the claims presently of record. Application of the reference Bradbury et al (US 2002/0059049) (“Bradbury”) to reject claims 1-20 of the present application is improper as discussed below.

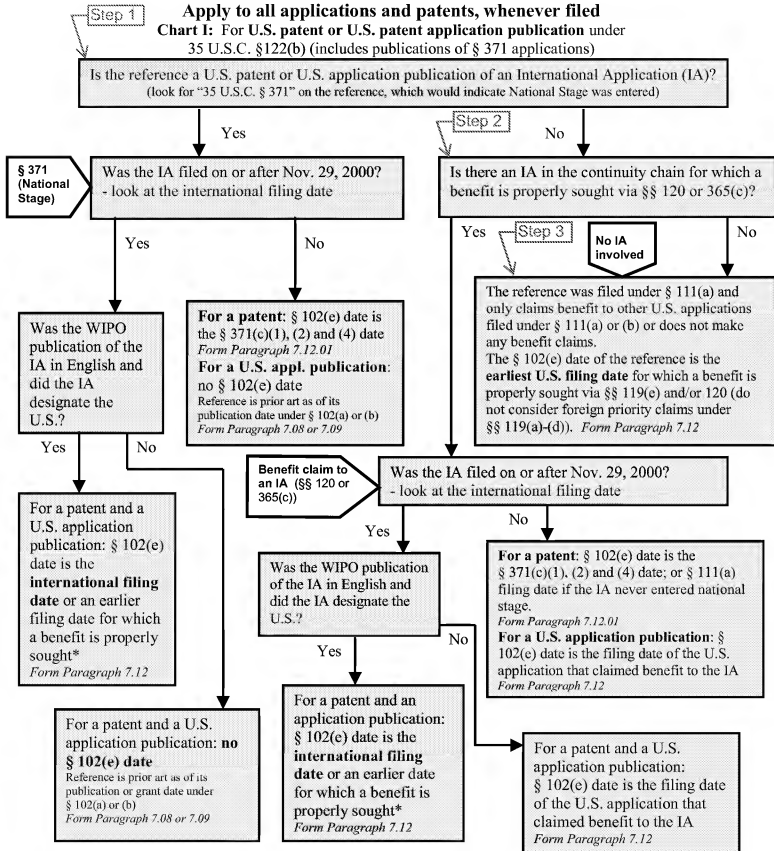
The 35 U.S.C. 102(c) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(c) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph. MPEP 706.02(f)(1).

Bradbury is a continuation-in-part of application No. 09/828,504, filed on April 5, 2001, which is a non-provisional of provisional application No. 60/194,965, filed on April 5, 2000. Thus, the effective prior art date of Bradbury under 35 U.S.C. § 102(e) is April 5, 2000.

The present application is the U.S. national stage entry of PCT/US00/22053 which claims priority from U.S. provisional applications Nos. 60/148,275, 60/148,277, and 60/148,393, all with the same effective filing date of August 11, 1999.

Thus, the present application is entitled to a priority date of August 11, 1999 while the effective prior art date of Bradbury under 35 U.S.C. § 102(e) is April 5, 2000. Thus, Bradbury is not prior art applicable to make a 35 U.S.C. § 103 rejection of the claims of the present application.

Bradbury’s effective prior art date is perhaps most effectively analyzed using the flowcharts of section III of MPEP 706.02(f). Specifically, Chart I: For U.S. patent or U.S. patent application publications under 35 U.S.C. § 122(b). A notated copy of Chart I is included below.

**FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:****Apply to all applications and patents, whenever filed****Chart 1: For U.S. patent or U.S. patent application publication under 35 U.S.C. §122(b) (includes publications of § 371 applications)**

\* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

### **Analysis of Chart I**

**Step 1** – Is the reference (Bradbury) a U.S. patent or U.S. application publication of an International Application (IA)? No, Bradbury is not a U.S. patent or U.S. application publication of an International Application. Alexander is a U.S. application publication of a U.S. Application, 09/828,504. Thus, the answer to the question in Step 1 is no.

**Step 2** – Is there an IA in the continuity chain for which a benefit is properly sought via §§ 120 or 365(c)? No, Bradbury is a U.S. application publication of U.S. Application 09/828,504 which is a non-provisional of provisional application No. 60/194,965. Thus, the answer to the question in Step 2 is No.

**Step 3** – Step 3 indicates the following:

The reference was filed under § 111(a) and only claims benefit to other U.S. applications filed under § 111(a) or (b) or does not make any benefit claims.

The § 102(e) date of the reference is the **earliest U.S. filing date** for which a benefit is properly sought via §§ 119(e) and/or 120 (do not consider foreign priority claims under §§ 119(a)-(d)).

The earliest U.S. filing date for Bradbury is April 5, 2000, which is a date later than the priority date of the present application, August 11, 1999. Therefore, Bradbury is not §102(e) prior art applicable to make a § 103 rejection of the present application.

## **CONCLUSION**

For the reasons above, the rejections of the pending claims of the present application in the final office action are improper. Review, reconsideration, and reversal are respectfully requested.

While no fees are believed due, the Office is hereby authorized to charge any necessary fees to Deposit Account No. 02-2051, referencing Attorney Docket No. 28728-65.

Respectfully submitted,

/ Luis A. Carrion/  
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